REMARKS

This Application has been carefully reviewed in light of the Office Action dated August 5, 2010 ("*Office Action*"). At the time of the *Office Action*, Claims 1-5, 7-22, 24-28, and 30-35 were pending and rejected. Applicants have amended Claims 1, 14, and 28 and add new Claims 36-38. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 112 Rejection

The Examiner rejects Claims 1-5, 7-22, 24-28, and 30-35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, with regard to Claim 1 (and Claims 14 and 28), the Examiner states that "[t]here is insufficient antecedent basis" for "the machine readable code" recited in the last step. (*Office Action*, page 2). Applicants respectfully disagree. The sixth step of Applicants' Claim 1 recites "using the computer operated by the merchant . . . to generate *a machine readable code* for the return shipping label . . . " The seventh step of Applicants' Claim 1 recites "using the computer operated by the merchant . . . to format the return shipping label, such that the return shipping label contains *the machine readable code . . .*" According to the seventh step, "*the machine readable code* [is] not associated with the carrier and [is] **in addition to** *a carrier-specified machine readable code* also present on the shipping label." Thus, Applicants' claim recites both *a machine readable code* and *a carrier-specified machine readable code*. The eighth (and last) step recites "scanning *the machine readable code* by the merchant or by the specialized returns center to correlate *the machine readable code* with one or more business rules for performing returns processing for a merchant associated with the transaction." Thus, the term "the machine readable code" is used throughout Applicants' Claim 1. The eighth step clearly refers to "the machine readable code" and not "the carrier-specified machine readable code." As such, Applicants respectfully submit that there is sufficient antecedent basis for the term "the machine readable code" in the eighth step of Applicants' Claim 1.

Second, with regard to Claim 1 (and Claims 14 and 28), the Examiner states that it is not clear whether the limitation "a merchant associated with the transaction" refers back to "the merchant" or another entity. (*Office Action*, page 3). Applicants appreciate the Examiner bringing this to Applicants' attention. Applicants have amended Claims 1, 14 and 28 to recite "the merchant associated with the transaction" rather than "a merchant associated with the transaction."

For at least these reasons, Applicants respectfully request that the rejection of Claims 1-5, 7-22, 24-28, and 30-35 under 35 U.S.C. § 112, second paragraph be withdrawn.

Section 103 Rejections

The *Office Action* states that Claims 1-5, 7-22, 24-28, and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013744 issued to Tsunenari et al. ("*Tsunenari*") in view of U.S. Patent No. 6,616,189 issued to Raming ("*Raming*") and further in view of Official Notice. (*Office Action*, page 3). However, based on the Examiner's application of the references to Applicants' claims and the Examiner's statement in the "Response to Arguments" section of the *Office Action*, it is clear to Applicants' that the Examiner intended to reject Claims 1-5, 7-22, 24-28, and 30-35 over *Tsunenari* in view of U.S. Patent No. 6,015,167 issued to Savino et al. ("*Savino*") and further in view of Official Notice.

Independent Claim 1 of the present Application, as amended, recites:

> A computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:
> accessing item data representing at least one detail about the item;
> accessing transaction data representing at least one detail about the transaction associated with the item including an identification of the transaction;
> accessing customer data representing at least one detail about a customer associated with the transaction including a shipping origin;
> accessing package data representing at least one detail about the package in which the item is expected to be shipped;
> using a computer operated by the merchant from whom the item was acquired or a specialized returns center associated with the merchant to process returns to correlate the item data, transaction data, customer data, and package data, with a set of stored business rules to determine

coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center;

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to generate a machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represented by the machine readable code comprises a plurality of data points, at least a first of the plurality of data points included in the machine readable code representing at least the shipping origin of the package and at least a second data point in the machine readable code representing the identification of the transaction;

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier, the machine readable code not associated with the carrier and in addition to a carrier-specified machine readable code also present on the shipping label; and

in response to receiving the package containing the item for return, scanning the machine readable code by the merchant or at the specialized returns center to correlate the machine readable code with one or more business rules for performing returns processing for the merchant associated with the transaction.

Thus, Applicants' claim relates to the generation of a return shipping label that "complies with the shipping label specifications of the choice the carrier" and includes both "machine readable code" and a "machine readable code." Applicants' claims further requires that the machine readable code is "not associated with the carrier." Whether considered alone or in combination, *Tsunenari* and *Savino* do not disclose, either expressly or inherently, each and every element of the claims.

In the *Office Action*, the Examiner relies upon *Tsunenari* for disclosure of "the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier, the machine readable code not associated with the carrier and in addition to a carrier-specified machine readable code also present on the

shipping label," as recited in Claim 1. (*Office Action*, page 6). Applicants respectfully disagree. *Tsunenari* merely discloses a "Web server generates shipping label data . . . sufficient for the client computer 100 to direct a printer 160 to print a shipping label that includes an identification of the destination and of the carrier service selected." (*Tsunenari*, paragraph 62). Figure 10I of *Tsunenari* provides a "graphical representation of the actual shipping label 1029." (*Tsunenari*, paragraph 81). *Tsunenari* specifies that the "in the format of the specific carrier." (*Tsunenari*, paragraph 81). Thus the shipping label is merely a typical carrier shipping label. Though the carrier shipping label includes a bar code 1029d, *Tsunenari* explains that the bar code is "used by the carrier for the pick-up and tracking of the parcel (such as a tracking number and some machine-readable bar codes)." (*Tsunenari*, paragraph 81). As such, *Tsunenari* merely discloses a standard shipping label having a single carrier-related bar code that is used by the carrier to track the package. *Tsunenari* does not disclose a return shipping label that includes both a machine readable code and a carrier-specified machine readable code. Accordingly, *Tsunenari* does not disclose, teach, or suggest "the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier, the machine readable code not associated with the carrier and in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

Savino does not cure the deficiencies of *Tsunenari*. While *Savino* describes "a shipping label" that includes "a single bar code" that is "linked with purchase and shipping information associated with a purchase order" (*Savino*, Column 2, lines 7-10), Applicants submit that the "shipping label" of *Savino* is not a shipping label at all. Rather, the label merely includes the bar code identifying a packing slip number and printed matter that relates to the customer purchase order no., the number of boxes, the quantity, and the customer part number (*Savino*, Figure 3). With regard to the "shipping label," *Savino* states:

FIG. 3 illustrates a shipping label 100 generated by the system 10 in accordance with the present invention. The shipping label includes a single-block bar code 102 which when scanned accesses the scanning system to a plurality of predetermined relevant purchase and shipping information associated with a purchase order which is stored in the supplier database 14 or digital processor 12. A "trigger number" 104 provides an alternative means for accessing the purchase and shipping information provided by the bar code 102. The shipping label 100 may also list some of the purchase and shipping information such as, for

example, a customer purchase order number 106, a box quantity number 108, a part quantity number 110 and a customer part number 112.

(*Savino*, column 3, lines 48-61). Thus, though the label is termed a "shipping label" it is not a carrier label and has none of the usual features of a shipping label. Rather, the "shipping label" is more likely a "packing slip" or something analogous to a packing slip. (*Savino*, Column 1, lines 36-50: Figures 3 and 5). Accordingly, neither *Tsunenari* nor *Savino* disclose a return shipping label that "complies with shipping label specifications of the choice of carrier" and includes both "the machine readable code not associated with the carrier" and "a carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

In the *Office Action*, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of *Tsunenari* to include the shipping label contains the machine readable code which represents customer address and identification of the transaction as taught by *Savino et al* for coordinating shipping and receiving information between supplier/merchant and customers in order to reduce the time consuming and costly." (*Office* Action, page 7). However, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate both bar codes in a single carrier label. The alleged advantages of the system disclosed in *Savino* do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the carrier label of *Tsunenari* to include the machine readable code of *Savino* while maintaining compliance with carrier specifications; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Stated differently, the combination of references do not explain how a merchant would create such a label that includes both a machine readable code not associated with the carrier and a carrier-specified machine readable code. If it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one

reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

In fact, *Savino* specifically relates to a "**single** bar code shipping label." (*Savino*, Column 2, lines 7-10, emphasis added). Throughout, *Savino* praises a label that includes a **single** bar code. According to *Savino*, "if for example, nine bar codes are provided with each packing slip, it will typically take about one minute to scan-in each nine-block label." (*Savino*, Column 1, lines 43-45). As another example, *Savino* explains that "several bar codes increases the likelihood that one or more of the bar codes provides incorrect information." (*Savino*, Column 1, lines 48-50). Thus, *Savino* actually teaches away from a shipping label that includes more than one bar code. As a result, the proposed combination merely results in a package having a first shipping label with a carrier-specific bar code (such as that disclosed in *Tsunenari*) and a second packing slip type label with an additional machine readable code (such as that disclosed in *Savino*). Accordingly, the proposed *Tsunenari-Savino* combination does not disclose "the return shipping label contains the machine readable code and complies with shipping label specifications of the choice of carrier, the machine readable code not associated with the carrier and in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

As still another example of the deficiencies of the *Office Action*, Applicants note the Examiner's acknowledgement that neither references discloses "at least a first of the plurality of data points included in the machine readable code representing at least the **shipping origin** of the package," as recited in Claim 1. (*Office Action*, page 7). Instead the Examiner states that "Official notice is taken that shipping origin information is well known to be included in the shipping label." (*Office action*, page 7). Applicants respectfully traverse this finding.

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. (M.P.E.P., §2144.03). Specifically, official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). (M.P.E.P., §2144.03). In appropriate circumstances, it

might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

In this case, the Examiner takes Official Notice to reject claim elements recited in an independent claim. Further, the Examiner merely takes Official notice "that shipping origin information is well known to be included in the shipping label." (*Office Action*, page 7). However, Applicants' claim language does not merely recite "including shipipng origin information in the shipping label." Instead, Applicants' claim language specifically recites "at least a first of the plurality of data points included in the machine readable code representing at least the **shipping origin** of the package." Thus, Applicants' claim language explicitly requires that "**shipping origin**" be included in the machine readable code. The Examiner has provided no evidence to support the Examiner's contention that it is indeed "old and well known" in the art to have "the return shipping label contain[] the machine readable code and complies with shipping label specifications of the choice of carrier, the machine readable code not associated with the carrier and in addition to a carrier-specified machine readable code also present on the shipping label," as recited in Applicants' independent Claim 1.

In this case, it would <u>not</u> be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (M.P.E.P., §2144.03). Accordingly, to the extent that the Examiner maintains this rejection based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 1, together with Claims 2-13 and 33-35 that depend on Claim 1. For analogous reasons, Applicants request reconsideration and allowance of independent Claims 14 and 28, together with Claims 15-27 and 29-32 that depend on Claims 14 and 28, respectively.

New Claims 36-38 are Allowable

New Claims 36-38 have been added and are fully supported by the original specification. No new matter has been added. New Claims 36, 37, and 38 depend upon independent Claims 1, 14, and 28, respectively. Claims 36-38 are not obvious over the cited references, whether considered alone or in combination, because Claims 36-38 at least because Claims 36-38 include the limitations of their respective independent claims, which Applicants have shown above to be allowable.

Additionally, Claims 36-38 recite claim elements that further distinguish the art. For example, Claim 36 recites "scanning the machine readable code on the return shipping label results in the identification of the shipping origin of the package and the method further comprises calculating the shipping charge due to the carrier based on the shipping origin identified as a result of scanning the machine readable code on the return shipping label." Claims 37-38 recite certain substantially similar limitations. These combinations of features is not disclosed, taught, or suggested in the prior art of record.

In fact, and as acknowledged by the Examiner on page 7 of the *Office Action*, *Tsunenari* does not disclose the machine-readable code, and thus, necessarily does not disclose "scanning the machine readable code on the return shipping label results in the identification of the shipping origin of the package and the method further comprises calculating the shipping charge due to the carrier based on the shipping origin identified as a result of scanning the machine readable code on the return shipping label." At most, *Tsunenari* discloses that the shipping label includes "an actualization code on the label, indicating that the shipping of the package on which the label is affixed has been pre-authorized and that the receiver (i.e., the manufacturer) will pay the shipping costs." (*Tsunenari*, paragraph 61). There is no disclosure, however, of the actualization code being represented within the machine readable code and then "scanning the machine readable code on the return shipping label results in the identification of the shipping origin of the package and the method further comprises calculating the shipping charge due to the carrier based on the shipping origin identified as a result of scanning the machine readable code on the return shipping label," as recited in Claims 36-38. Rather, *Tsunenari* merely discloses that the shipping label includes a bar code "used by the carrier for the pick-up and tracking of the parcel." (*Tsunenari*, paragraph 81). Since *Savino* does not cure these deficiencies, Applicants respectfully submit that Claims 36-38 are allowable over the cited references.

For at least these reasons, Applicants respectfully submit that new Claims 36-38 are allowable over the prior art.

CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 415-4820.

The Commissioner is hereby authorized to charge any $156.00 for the addition of three (3) new claims, any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants

Jenni R. Moen
Reg. No. 52,038

Date: November 5, 2010

Correspondence Address:

at Customer Number: **05073**